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10/824,693	04/15/2004	James W. Blease	87261SMR	8140

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EXAMINER

KLEMANSKI, HELENE G

ART UNIT

PAPER NUMBER

1755

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/824,693

Applicant(s)

BLEASE ET AL.

Examiner

Helene Klemanski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-18,26,27,29,30,32-36 and 40-44 is/are rejected.
- 7) ☒ Claim(s) 3,19-25,28,31 and 37-39 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4/15/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 26-28 and 41 are objected to because of the following informalities: in claim 26, a period should be inserted after the last formula; in claim 27, line 2, the comma between the number "31" and the term "b)" should be replaced with the term "or"; also in claim 27, the first line after formula (V), the period should be replaced with a semi-colon; in claim 28, line 2, the phrase "pacified reactive black" should be replaced with the phrase "Pacified Reactive Black" and in claim 41, line 4, the term "or" should be deleted. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 30, 36 and 41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 30 and 36, the terms "Kodak Lightfast Magenta 1 (CAS # 251959-65-6)", "CAS # 182061-89-8", "Nippon Kayaku JPD EK-1 (CAS # 224628-70-0)" and "CAS # 212080-60-9" are considered indefinite since the relationship between a trademark (or a tradename) and the product it identifies is sometimes indefinite, uncertain or arbitrary. The formula or characteristics of the product may change from time to time and yet it may be sold under the same trademark. In the claims, every element or ingredient of

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the should be set forth in positive, exact, intelligible language, so that there will be no uncertainty as to what is meant. Arbitrary trademarks which are liable to mean different things at the pleasure of manufactures do not constitute such language. See Ex parte Kattwinkel, 12 U.S.P.Q. 11 and MPEP 608.01(v).

In claim 41, the phrase "selected from" is considered indefinite since this is improper Markush language. It is the examiner's position that other materials could be present in the Markush group that were not intended by applicants by the use of the phrase "selected from" since this phrase does not exclude other materials. The examiner suggests the language "selected from the group consisting of" in place of this phrase.

### ***Claim Rejections - 35 USC § 103***

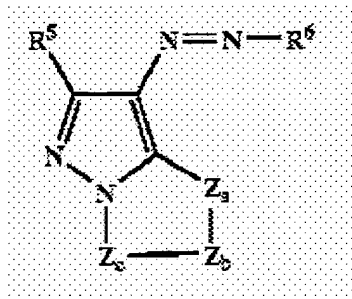
4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

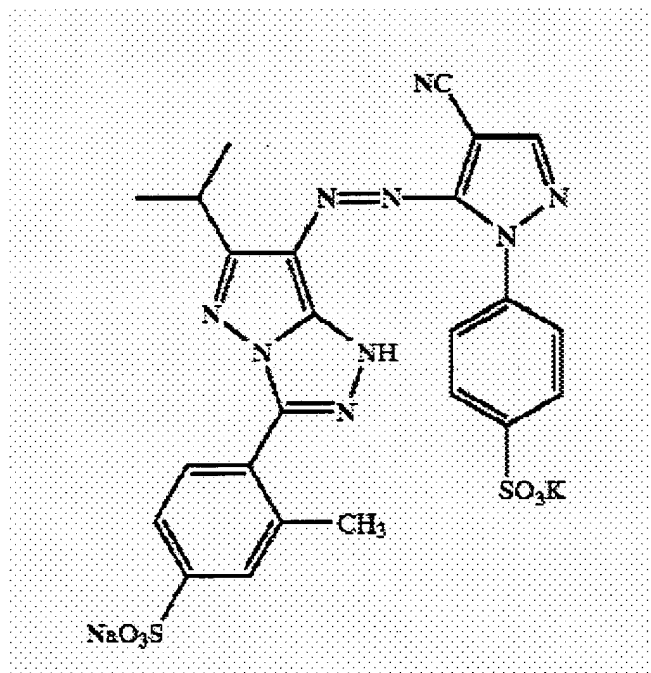
5. Claims 1, 2, 4-18, 26, 27, 29, 32-35 and 40-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishita et al. ('195) in view of Peter.

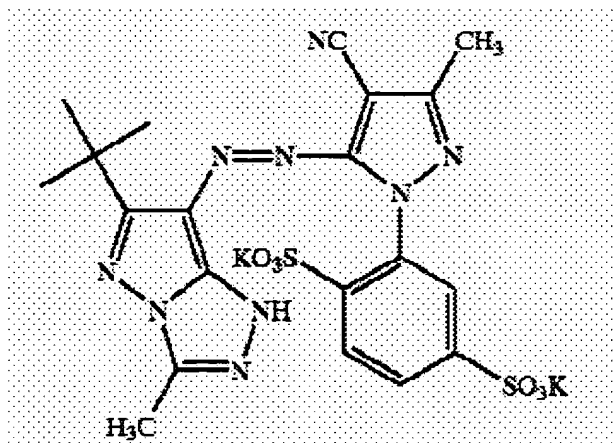
Nishita et al. ('195) teach an ink composition comprising 0.2-20 parts by weight of at least one water-soluble dye of the formula

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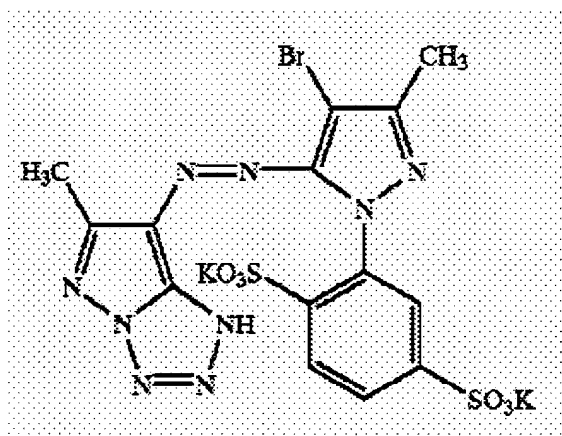


wherein  $R^5$  is H, cyano, alkyl, cycloalkyl, aralkyl, alkylthio, arylthio or an ionic hydrophilic group;  $Z_a$  is  $-N=$ ,  $-NH-$  or  $-C(R^{11})=$  and  $Z_b$  and  $Z_c$  each independently are  $-N=$  or  $-C(R^{11})=$ ;  $R^{11}$  is H or a non-metallic substituent and  $R^6$  is an optionally substituted heterocyclic group, a water-soluble organic solvent, an anti-drying agent (i.e. humectant), pH adjusting agents and water. Specific dyes are of the following formulas





and



Nishita et al. ('195) further teach an ink jet ink set comprising a cyan ink containing a sulfonated copper phthalocyanine dye and a medium, a light cyan ink containing a sulfonated copper phthalocyanine dye and a medium, a magenta ink containing an azo-naphthol derivative dye and a medium, a light magenta ink containing an azo-naphthol derivative dye and a medium, a yellow ink comprising the above ink composition and a black ink containing a black dye and a medium. Nishita et al. ('195) also teach an ink jet printing method comprising ejecting the above ink onto a substrate. See col. 2, lines 28-30, col. 3, lines 13-33, col. 8, lines 56-65, col. 9, lines 1-7, compounds 2-15, 2-16 and 2-19, col. 21, lines 3-6, col. 27, lines 19-65, col. 28, lines 21-23, col. 29, lines 21-38,

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col. 34, lines 14-16, Table 3, col. 35, lines 1-40, col. 36, lines 1-40 and claim 1. Nishita et al. ('195) fail to specifically exemplify the use of the dye of the formulas as claimed by applicants and the use of a metal complex black dye as the black dye in the black ink.

Peter teaches an ink jet ink composition containing a metal complex black dye. See col. 5, line 15 – col. 6, line 1, col. 7, lines 21-28, col. 17, lines 50-62 and claim 10.

Therefore, it would have been obvious to one having ordinary skill in the art to use the specific dyes of the formulas as claimed by applicants as Nishita et al. ('195) also discloses the use of these dyes but fails to show an example incorporating them.

Therefore, it would have been obvious to one having ordinary skill in the art to have replaced the black dye of Nishita et al. ('195) with the metal complex black dye of Peter because the substitution of art recognized equivalents as shown by Peter would have been within the level of ordinary skill in the art.

#### ***Allowable Subject Matter***

6. Claims 3, 19-25, 28 and 37-39 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. Claims 30 and 36 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

8. The following is a statement of reasons for the indication of allowable subject matter: Nishita et al. ('195) fail to teach or fairly suggest an ink jet ink set (1) wherein

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the yellow dye is represented by Structure II as claimed; (2) wherein the black ink contains Pacified Reactive Black of the formula VIII or IX; (3) wherein the magenta ink (and light magenta ink) contains the specific dyes in claims 30 and 36; (4) wherein the black ink contains a metal complex black dye and the above yellow dye; (5) wherein the ink set further comprises a light yellow ink containing the above yellow dyes and (6) wherein ink set further comprises a light black ink containing a metal complex black dye, a carbon black pigment, a self-dispersing carbon black pigment or mixtures thereof.

### ***Conclusion***

The remaining references listed on forms 892 and 1449 have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the above rejections.

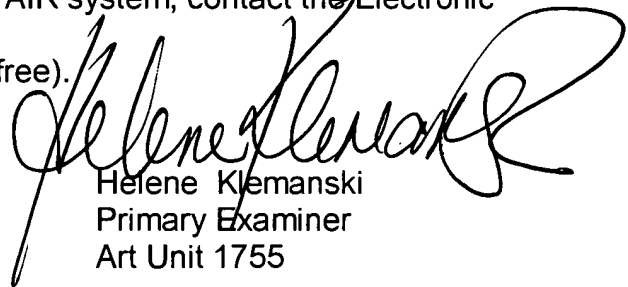
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helene Klemanski whose telephone number is (571) 272-1370. The examiner can normally be reached on Monday-Friday 5:30-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Helene Klemanski  
Primary Examiner  
Art Unit 1755



NK  
June 25, 2005